

## **REMARKS**

The Office Action dated May 9, 2006, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Preliminary Amendment, claims 1, 6-10 have been amended. No new matter has been added. Support for the amendments to the claims can be found on at least page 17, line 28 to page 19, line 5 of the specification as originally filed. Claims 1-3 and 5-10 are pending and respectfully submitted for consideration.

### **Rejection Under 35 U.S.C. § 103**

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hassett et al. (U.S. Patent No. 5,144,553, "Hassett") in view of Deaton et al. (U.S. Patent No. 6,611,811 B1, "Deaton"). The Applicant respectfully points out to the Examiner that claim 4 has been canceled. The Applicant again points out to the Examiner that the patent number in the Office Action for the Deaton reference is incorrect. The correct patent number for Deaton is indicated above.

Hassett was cited for disclosing many of the claimed elements of the invention with the exception of setting the initial numbers of media higher with purchase dates during an earlier time period. Deaton was cited for teaching providing incentives for customers who make purchases during earlier time periods. The Applicant traverses the rejection and respectfully submits that claims 1-3 and 5-9 recite subject matter that is neither disclosed nor suggested by the cited references.

As a result of the claimed invention, the advantages offered by claims 1 and 10 is that the initial available numbers of times of unitary use of prepaid available number-of-

times-of-unitary-use storage media purchased after their advance sale are set in a way such that the earlier the purchase dates and times of the storage media are, the larger the initial numbers of the storage media are; therefore, users are induced to buy storage media earlier, enabling the service provider to recover its investment earlier and the users themselves to make use of the service inexpensively.

Hassett discloses a system for automatic collection of tolls, including a toll facility, an in-vehicle toll processor having memory for storing a toll-money-available quantity purchased by the user, and a toll-facility-identification site that transmits a toll-facility-identifier signal indicating the identity of the upcoming toll facility and the toll to be collected. As the vehicle approaches the identification site, the in-vehicle processor receives the identifier signal and calculates the toll to be debited. When the vehicle passes through the toll facility, the facility transmits a toll-collect signal instructing the in-vehicle toll processor to debit the calculated toll from memory. The in-vehicle processor debits the calculated amount and transmits an acknowledgement signal to the toll facility.

Deaton discloses a method and system for accumulating marginal discounts and applying an associated incentive upon achieving a threshold. The system can also predict a customer's next due date to purchase a type of product. If a customer begins a pattern of buying a certain type of diapers, for example, but the customer is an infrequent shopper or sub-par spender, this system may induce that customer to shop more often or to spend more by issuing an incentive to the customer to purchase diapers at the time which the customer's history has indicated that the customer buys diapers. By tracking the purchase cycle of various products, the system can anticipate

the next purchase date in order to issue incentives prior to that anticipated purchase date, or issue other incentives if the next purchase date passes and no purchase is made.

Claims 1 and 10 as amended, recite, in part, an initial value-setting system for setting the initial available numbers of times of unitary use of prepaid available number-of-times-of-unitary-use storage media for a plurality of users who make use of a certain toll or pay service, the initial value-setting system wherein the sales to date comprise total sales to date to a plurality of users, and wherein the larger the total sales to date is, the larger the initial number of times of unitary use is set, and the more rapidly the total sales to date increases, the more rapidly the initial number of times of unitary use increases.

With respect to claims 1 and 10, the Applicant respectfully submits that Hassett fails to disclose or suggest additional features of the invention beyond those acknowledged in the Office Action. Claims 1 and 10 recite eight different storage areas for storing different information. There is a first storage area for storing the opening date and time of advance sale of the media, a storage area for storing the closing date and time of the advance sale, a storage area for storing a closing date and time of ordinary sale of the media, a storage area for storing a target annual sales of the media, a storage area for storing a selling price of the media, a storage area for storing a toll expressed in the number of times of unitary use of the service, a storage area for storing a most preferential initial number of times of unitary use applicable to media purchased during the advance sale, and a storage area for storing the sales from the opening date and time of the advance sale to the purchase date and time of each

medium. The Office Action took the position that these storage areas are disclosed in Hassett, column 5, lines 64-68; column 16, lines 33-68; and column 18, lines 10-21.

However, column 5, lines 64-68 merely discloses "a Toll Transaction Management (TTM) system 32 for recording toll transactions for the toll authority, and cash terminals 17 coupled to the TTM for enabling vehicle operators to purchase prepaid toll-money-available quantities." Column 16, lines 33-68 merely discloses, in part, "a storage module 143 having conventional RAM, magnetic, optical or other digital data memory and storage elements." Column 18, lines 10-21 merely discloses that "[e]ach of the TTM Records described above contains selected information relating to toll transactions. Data fields utilized in one practice of the invention are set forth below, by way of example... the invention can be practiced with data fields other than those set forth below." The TTM Records include Cash Transaction Records, Traffic Records, and Cash Summary Records. The Applicant notes that the TOLL PURCHASE/CASH TRANSACTION DATA FIELDS disclosed in column 18, line 31 of Hassett does not indicate a purchase date and time.

The Office Action took the position that the storage areas are "duplication of parts (one storage area versus three storage areas)" and perform the same result. See page 3, lines 7-10 of the Office Action. The Office Action further took the position that the duplicate parts are for multiple effects. The Applicant notes that the cases cited by the Examiner in the Office Action (St. Regis Paper and In re Harza) do not provide any teaching regarding "duplicate parts for multiple effects".

As such, the Applicant respectfully submits that there is no disclosure or suggestion in Hassett of at least the feature of eight different storage areas storing the

different information recited in claims 1 and 10. Hassett merely discloses the existence of a sale. The different storage areas recited in claims 1 and 10 contain information used in the initial value-setting means having functions f1-f4 that rely on the data of the different storage areas.

Under U.S. patent practice, “[i]t is error to ignore specific limitations of a claimed invention which distinguish over a cited reference or references.” In re Glass, 176 U.S.P.Q. 49 (CCPA 1973) (citing In re Chandler, 117 U.S.P.Q. 361 (CCPA 1958)). Further, “[s]ilence in a reference is not a proper substitute for adequate disclosure of facts from which a conclusion of obviousness may justifiably follow.” In re Burt, 148 U.S.P.Q. 548 (CCPA 1966). In this case, Hassett does not disclose or suggest each of the claimed storage areas recited in claims 1 and 10, and it appears that the Office Action ignored the features of the different storage areas. As such, the Applicant respectfully submits that Hassett fails to disclose or suggest additional features of the invention, beyond those acknowledged in the Office Action.

With respect to claims 1 and 10, the Applicant respectfully submits that Deaton fails to cure the deficiencies in Hassett. The Applicant respectfully submits that while Deaton teaches that sales by the purchase of a specific individual give the incentive to the individual, the present invention teaches that total sales by the purchase of a plurality of users gives incentives to the plurality of users. Specifically, Deaton merely discloses that a customer's purchase benefits the customer alone, while the present invention, as recited in claims 1 and 10, provides that the total sales of a certain toll or pay service used by a plurality of users gives incentives to the plurality of users. As such, Deaton fails to disclose or suggest at least the feature of the sales to date

comprising total sales to date to a plurality of users, wherein the larger the total sales to date is, the larger the initial number of times of unitary use is set, and the more rapidly the total sales to date increases, the more rapidly the initial number of times of unitary use increases. Therefore, Deaton fails to cure the deficiencies in Hassett with respect to claims 1 and 10. Accordingly, the combination of Deaton and Hassett fails to disclose or suggest each and every feature of the invention as recited in claims 1 and 10.

The Applicant respectfully submits that Deaton further fails to cure the deficiencies in Hassett with respect to claims 1 and 10, as Deaton does not disclose or suggest an initial value-setting means for setting the initial numbers of media with purchase dates and times between the opening and closing dates and times of the advance sale higher than those of media with purchase dates and times between the closing dates and times of the advance and ordinary sale. In contrast, Deaton discloses that "[b]y tracking the purchase cycle of various products, the system can anticipate the next purchase date in order to issue incentives prior to that anticipated purchase date, or issue other incentives if the next purchase date passes and no purchase is made." See column 70, lines 11-15 of Deaton.

As such, Deaton teaches the opposite of claims 1 and 10, that is, incentives provided after the initial purchase, after the customer "begins a pattern of buying a certain type" of products. See column 70, lines 5-6 of Deaton. There is nothing in Deaton about incentives provided "at earlier time periods" as asserted in the Office Action. In contrast, Deaton teaches incentives for future purposes only, not initial purchases as recited in claims 1 and 10. Further, Deaton discloses, in part, that

"[a]ssuming a predetermined criteria has been met, the customer is provided an incentive to return to the store by granting the customer an electronic discount on specific products purchased in the current transaction and, in addition, is notified of an electronic discount the customer would receive upon purchasing products in a future transaction." (emphasis added). See column 141, lines 6-17.

The features of setting "initial numbers of media" and "opening and closing dates and times" and "advance sales as distinct from ordinary sales" is not disclosed or suggested in Deaton. Therefore, Deaton fails to cure the deficiencies in Hassett with respect to claims 1 and 10.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the

present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 1 and 10 under 35 U.S.C. §103.

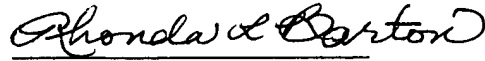
### **Conclusion**

The Applicant respectfully submits that claims 1 and 10 are allowable. Claims 2-3 and 5-9 depend from claim 1. The Applicant respectfully submits that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above with respect to claim 1. Accordingly, the Applicant respectfully requests withdrawal of the rejections, allowance of claims 1-3 and 5-10, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

Please charge any fee deficiency or credit any overpayment to counsel's Deposit  
Account No: 01-2300, **referencing Attorney Dkt. No. 107390-00006.**

Respectfully submitted,



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Enclosures: Request for Continued Examination

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